

## **REMARKS**

In the Office Action, Claims 1-29 were examined. Claims 1-4 and 6-9 stand rejected, Claims 5 and 10 are objected and Claims 11-29 are allowed. In response to the Office Action, Claims 1, 5, 6 and 10 are amended, no claims are cancelled and no claims are added. Applicants respectfully request reconsideration of pending Claims 1-29 in view of the following remarks.

### **I. Objection to the Specification**

The Examiner has objected to the specification because the present invention does not contain a "Summary of the Invention" section. However, Applicants would like to kindly point out that neither the M.P.E.P nor 37 C.F.R. §1.73 require the presence of a "Summary of the Invention" in a patent application. They merely indicate where in the application the "Summary of the Invention" should be placed if Applicants were to elect to include one.

In particular, 37 C.F.R. §1.73 only states that "[a] brief summary of the invention . . . should precede the detailed description." 37 C.F.R. §1.73 does not state "must" or "shall." Accordingly, Applicants have elected not to include a "Summary of the Invention" as this is within the discretion of Applicants.

### **II. Claims Rejected Under 35 U.S.C. §112**

The Examiner rejects Claims 1-10 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which Applicants regard as the invention.

Regarding Claims 1 and 6, Claims 1 and 6 are amended as follows:

enabling a hardware accelerator selected from a plurality of hardware accelerators according to at least one bit of a register within the register file set by a processing element.

Applicants respectfully submit that Claims 1 and 6, as amended, now particularly point out and distinctly claim the subject matter, which Applicants regard as the invention. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the 35 U.S.C. §112, second paragraph, of Claims 1 and 6, as well as Claims 2 and 5, based on their dependency from Claim 1 and Claims 7 and 10, based on their dependency from Claim 6.

### **III. Claim Objections**

The Examiner objects to Claims 5 and 10 for minor informalities. Applicants have amended Claims 5 and 10 to incorporate the Examiner's requested amendments. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the objections to Claims 5 and 10.

#### IV. Claims Rejected Under 35 U.S.C. §103

The Examiner rejects Claims 1-4 and 6-8 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,624,816 issued to Jones, Jr. et al. ("Jones") in view of U.S. Patent No. 6,311,204 issued to Mills ("Mills"). Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, the following criteria must be met: (1) there must be some suggestion or motivation to modify the reference or combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. (MPEP §2142)

Regarding the Examiner's citing of Jones, Applicants respectfully submit that pursuant to 35 U.S.C. §103(c), Jones is not a valid §103(a) reference, which may be combined with Mills to preclude the patentability of Claims 1-4 and 6-8. Therefore, pursuant to §103(c), Jones cannot be combined with Mills to preclude the patentability of Claims 1-4 and 6-8 under 35 U.S.C. §103(a).

Pursuant to 35 U.S.C. §103(c):

Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g), of §102 of this title, shall not preclude patentability under this section where the subject matter in the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Here, Jones was filed on September 10, 1999 and issued on September 23, 2003, following the filing date of the present application, which was filed on June 23, 2003. Accordingly, Jones only qualifies as prior art under 35 U.S.C. §102(e). Furthermore, the subject matter described in Jones and the subject matter of all pending claims were, at the time the invention was made, subject to an obligation of assignment to the Intel Corporation. Therefore, pursuant to 35 U.S.C. §103(c), Jones is disqualified as a valid §103(a) reference. Hence, §103(c) prohibits the Examiner from relying on the combination of Jones in view of Mills to preclude the patentability of Claims 1-4 and 6-8.

Accordingly, Applicants respectfully submit that the Examiner fails to establish a *prima facie* case of obviousness of Claims 1-4 and 6-8 under 35 U.S.C. §103(a), since §103(c) prohibits the Examiner from relying on the combination of Jones in view of Mills to render Claims 1-4 and 6-8 obvious under §103(a).

Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claims 1 and 6. Furthermore, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claims 2-4, based on their dependency from Claim 1 and Claims 7 and 8, based on their dependency from Claim 6.

**V. Allowable Subject Matter**

Applicants note with appreciation the Examiner's indication that Claims 11-27 are allowed. Regarding the allowance of Claims 11-27, Applicants would respectfully like to thank the Examiner for recognizing the allowability of such claims.

The Examiner has indicated that Claims 5 and 10 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112, second paragraph.

Regarding Claims 5 and 10, Applicants would respectfully like to thank the Examiner for recognizing the allowability of Claims 5 and 10 if incorporated into their respective independent Claims 1 and 6. However, Applicants respectfully submit that Claims 5 and 10 are also patentable, based on their dependency from Claims 1 and 6, respectfully. Therefore, Applicants respectfully request that the Examiner allow Claims 5 and 10.

**CONCLUSION**

In view of the foregoing, it is submitted that Claims 1-29 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: April 26, 2005

By: \_\_\_\_\_

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**CERTIFICATE OF MAILING:**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 26, 2005

Marilyn Bass  
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April 26, 2005